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09/872,704	06/01/2001	Randy L. Morningstar	687-442	2503

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EXAMINER

ODLAND, KATHRYN P

ART UNIT PAPER NUMBER

3743

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20040513

Application Number: 09/872,704
Filing Date: June 01, 2001
Appellant(s): MORNINGSTAR, RANDY L.

Jeffrey Hohenshell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 12, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 52-61 are allowed. Claims 14-15 and 18-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Upon review of appellant's arguments, the rejection of claims 14-15, 18-19 and 52-61 has been withdrawn.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-9, 11-13 and 16 stand or fall together. Claims 10 and 17 stand or fall together. Upon review of appellant's arguments, the rejection of claims 14-15, 18-19 and 52-61 has been withdrawn.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4327912	Hoffman	5-1982
5720734	Copenhaver	2-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-9, 11-13 and 16 rejected under 35 U.S.C. 102(b). This rejection is set forth in prior Office Action, Paper No. 17. Claims 10 and 17 are rejected under 35 U.S.C. 103(a). These rejections are set forth in prior Office Action, Paper No. 17.

(11) Response to Argument

Appellant argues, "Hoffman does not teach or suggest having a piercing configured to remain closed unless penetrated by a relatively rigid member." The examiner respectfully disagrees. Hoffman clearly recites, "As shown in FIG. 13, valve 42 is disposed to allow fluid flow passage in the direction of arrow 44 and prevent fluid flow in the direction of arrow 46" in column 4, lines 46-51. Further, Hoffman recites, "With tennis ball 92 incorporating valve 66, if it should be necessary to reduce the inflation pressure, all that is necessary is to insert a toothpick, paper clip, or the like into the

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valve opening so as to spread the sealing lips part and break the seal" in column 8, lines 48-55. Clearly, this recitation demonstrates that the piercing, formed from a blade, as discussed in column 5, lines 60-65 is configured to remain closed since it is described as a virtually leak-proof system.

Further appellant argues, that the ball must be placed in a pressurized storage container to be fully inflated. This discussion is irrelevant to the claim language. Nonetheless, the Hoffman device is capable of being inflated via numerous methods and the disclosure merely states that the tennis ball can be formed by placement in a pressurized environment. The claim language does not preclude pressurization and if appellant invention were placed in a pressurized environment it would not behave unlike that disclosed by Hoffman.

Appellant also argues, "Hoffman does not teach or suggest an implantable balloon." However, the balloon of Hoffman is capable of being implanted and in a reasonably broad interpretation is implanted in the container discussed throughout the patent. Appellant's claim 1 merely recites in the preamble that the balloon is implantable. It is not limited by where it can be implanted. Thus, this extraordinarily broad recitation can be accomplished by implanting the ball in the ground, in a container – such as the pressurized container discussed, etc. Regarding the preamble of claim 11, it recites a self-sealing medical balloon of unitary construction implantable in a human body. However, it is not inconceivable that a balloon/ball of the size disclosed by Hoffman could not be implanted in the human body. There is a plethora of different sized and shaped balloons for implantation into the human body. One example would

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be balloons placed in the stomach as part of gastric surgery to reduce the size of the stomach and invoke fullness. Thus, the Hoffman balloon has the inherent capability of being implanted in the human body. Moreover, the body of the claim does not amplify the preamble or rely on it for completeness such that it would define over the structure disclosed by Hoffman.

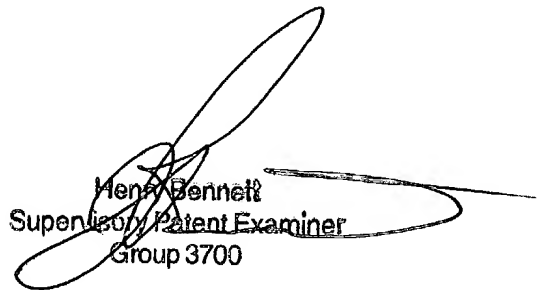
Finally, the rejection of claims 10 and 17 under 35 U.S.C. 103 does not rely on Copenhaver for its motivation. Thus, the argument with respect to Copenhaver and its combinability with Hoffman is extraneous.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

KO
May 16, 2004

Conferees
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